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REMARKS

Entry of the previous amendments is respectfully requested. Claims 1, 4, and 6 have been amended. New claims 20 and 21 have been added. Claims 18 and 19 have been withdrawn. Claims 1-17, 20, and 21 are currently pending in the application. Favorable reconsideration and allowances are respectfully requested in light of the foregoing amendments and the following remarks.

1. Claim Rejections Under 35 U.S.C. §102

A) Claims 1-5, 9, 10, 12-14, 16, and 17

In the Office Action, the Examiner has rejected claims 1-5, 9, 10, 12-14, 16, and 17 under 35 U.S.C. §102(b) as being anticipated by Clark et al., U.S. Reissue Patent No. RE 24,554 (the '554 patent).

Applicant respectfully traverses the Examiner's rejections to claims 1-5, 9, 10, 12-14, 16, and 17 based on the '544 patent. More specifically, with this response, Applicant has amended claim 1 to specify that the method consists essentially of the steps of providing the substrate, applying a colorant to the substrate, and applying an overcoat to the substrate over the colorant. Thus, only a single colorant is applied to the substrate in the method of claim 1. In addition, claim 1 has also been amended to specify that the colorant consists essentially of a non-white pigment, a thickener, and a solvent. Thus, the colorant includes only a single pigment in conjunction with the thickener and the solvent.

Conversely, the '554 patent discloses a heat-sensitive copying-paper in which an undercoat having a specific color is applied to a paper beneath a non-transparent heat-sensitive layer including a pigment that is activated when heated. Thus, the '554 patent discloses a paper having two separate colorants supplied to the substrate, which is expressly excluded from the scope of amended claim 1.

As a result, Applicant believes the subject matter of claim 1 is not shown or described in the '544 patent, such that claim 1 is allowable. Further, based on their dependency from claim 1,

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Applicant also believes that claims 2-5, 9, 10, 12-14, 16, and 17 are also allowable, and respectfully requests that the Examiner withdraw her rejections to these claims.

B) Claims 1-6, 12-14, 16, and 17

In the Office Action the Examiner has also rejected claims 1-6, 12-14, 16, and 17 under 35 U.S.C. §102(b) as being anticipated by PCT Publication No. WO 99/23179 (the '179 reference).

Applicant respectfully traverses the Examiner's rejections to claims 1-6, 12-14, 16, and 17 based on the '179 reference. More specifically, as stated previously, with this Response, Applicant has amended claim 1 to specify that the method is limited to the steps of providing the substrate, applying the colorant to the substrate wherein the colorant consists essentially of a pigment, thickener, and a solvent, and applying an overcoat to the substrate over the colorant.

Conversely, the '179 reference discloses a single or multi-layered coating for a paper including at least one dark colorant and a white or near-white pigment in conjunction with a binder and a solvent. Thus, the '179 reference does not disclose a colorant consisting essentially of a single pigment, a thickener, and a solvent as required by claim 1. Therefore, the subject matter of claim 1 is neither shown nor described by the '179 reference, such that claim 1 is allowable. Further, based on their dependency from claim 1, Applicant also believes that claims 2-6, 12-14, 16, and 17 are also allowable and respectfully requests that the Examiner withdraw the rejections to these claims.

2. Claim Rejections Under 35 U.S.C. §103

A) Claims 11 and 15

In the Office Action, the Examiner has rejected claims 11 and 15 under 35 U.S.C. §103(a) as being unpatentable over the '554 patent.

Applicant respectfully traverses the Examiner's rejections of claims 11 and 15 based on the '554 patent. More specifically, as discussed previously regarding the rejection of claim 1 in light of the '554 patent, Applicant believes that the subject matter of claim 1 is neither shown nor

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described by the '554 patent, and is therefore allowable. Because claims 11 and 15 depend from claim 1, and therefore incorporate all of the limitations of claim 1, Applicant also believes that claims 11 and 15 are allowable. Applicant therefore respectfully requests that the Examiner withdraw her rejections to claims 11 and 15.

B) Claims 1-3 and 5-8

In the Office Action, the Examiner has rejected claims 1-3 and 5-8 under 35 U.S.C. §103(a) as being unpatentable over European Patent Application No. 1,176,255 (the '255 reference).

Applicant respectfully traverses the Examiner's rejections of claims 1-3 and 5-8 based on the '255 reference. More specifically, as stated previously with this response, Applicant has amended claim 1 to specify that the method is limited to the steps of providing the substrate, applying the colorant to the substrate, and applying the overcoat to the substrate over the colorant. Further, the colorant as claimed in claim 1 consists essentially of a non-white pigment, a thickener, and a solvent. The added limitation of a non-white pigment as recited in claim 1 is supported in the application on page 4, lines 4-8, where the dye stuff or pigment is defined as a compound within the class of other basic dyes or anionic direct or fiber reactive dyes, or a pigment that can impart a color to a cellulosic material such as a dry coloring matter. Thus, the purpose of the pigment is to alter the color of the substrate in a manner that requires the pigment to add a color to the substrate other than white.

Conversely, the '255 reference discloses a coating composition including a pigment such as clay, calcium carbonate, calcium sulfoaluminate (satin white), talc, titanium dioxide, barium sulphate, silica, or plastic pigments based on polymer particles that are utilized to provide a white appearance to the substrate. The composition can also include additional ingredients, such as dyes, to impart a color to the substrate separate from the pigment. Thus, the '255 reference does not disclose a method including a step of applying a colorant having a non-white pigment, a binder and solvent as required by claim 1. As a result, the subject matter of claim 1 is neither shown nor described by the '255 reference, such that claim 1 is allowable. Further, based on

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their dependency from claim 1, Applicant believes that claims 2, 3, and 5-8 are also allowable, and Applicant respectfully requests the Examiner withdraw the rejection to these claims.

3. Claim Rejections Under 35 U.S.C. §112

In the Office Action, the Examiner has rejected claim 6 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant respectfully traverses the Examiner's rejection of claim 6 under 35 U.S.C. §112, second paragraph. More specifically, with this response, Applicant has amended claim 6 to specify that the thickener is a polysaccharide, such that the scope of the claim is now definite. As a result, Applicant respectfully requests that the Examiner withdraw her objection to claim 6.

4. New Claims 20 and 21

With this response, Applicant has added new claims 20 and 21 which are similar in scope to claims 1 and 3, with claim 20 specifically stating that the colorant consists essentially of a dye, a thickener, and a solvent and claim 21 stating that the dye is a direct dye having a compound represented by the formula illustrated in claim 21. Based on the similarity of the scope of claim 20 to claim 1, which Applicant believes is allowable, Applicant also believes that claims 20 and 21 are allowable as well.

CONCLUSION

It is submitted that claims 1-17, 20, and 21 are in compliance with 35 U.S.C. §§112, 102, and 103 and each defines patentable subject matter. A Notice of Allowance is therefore respectfully requested.

The director is authorized to charge Deposit Account No. 50-1170 the amount of \$125.00 in payment of the fee for one claim in excess of 20 and one independent claim in excess of 3 by a small entity. No additional fees are believed to be payable with this communication.

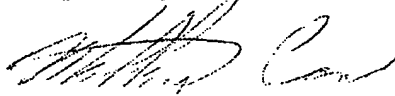
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Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the director is authorized to charge any fee or credit any overpayment to Deposit Account No. 50-1170.

In view of the foregoing amendments and remarks, the application is believed to be in prima facie condition for allowance, and such action is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it would help expedite the prosecution and allowance of this application.

Respectively submitted,



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